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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,442	11/13/2003	James Phifer	5078-0001	8711
7590	10/28/2005		EXAMINER	
Michael L. Diaz Michael L. Diaz, P.C. Suite 200 555 Republic Drive Plano, TX 75074			BANGACHON, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/712,442	PHIFER, JAMES	
Examiner	Art Unit		
William Bangachon	2635		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 November 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20 is/are rejected.

7)  Claim(s) 1,13,18 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 13 November 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/13/03

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Objections***

1. Claims 1, 13 and 18 are objected to because of the following informalities:  
The word “**suppling**” in pages 17, 21 and 23 is misspelled. Should be “**supplying**”.

It is noted that the terms “**capable**” and “**adapted**” has been extensively used in the claims. It has been held that the recitation that an element is “**capable of**” or “**adapted for**” performing an action is not a positive limitation but only requires the ability to do so. The terms do not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
3. Claims 13, 15 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in claims 13 and 18 on how the remote control device distinguishes between the control signals for a television and the control signals for the VCR or DVD.

Claim 15 recites of a second keypad but missing the first keypad. It should be dependent on claim 14 in order to recite the first keypad.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 2, 9 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,483,440 (Welch).

In claim 1, Welch teaches of an ergonomic remote control device for the remote control of a television set, the remote control device comprising:

a housing substantially in the shape of a control stick, adapted for being held by a human hand and being manipulated by the digits of the hand, fixed to a base (70) such that the housing will stand upright as shown in figures 1 and 2 {col. 3, lines 16+},

a plurality of control switches (60) mounted on said control stick positioned to be manipulated by the digits of the hand,

an infrared transmitting light diode (80) housed in said control stick for transmitting television viewing control signals to a television set {paragraph bridging cols. 3 and 4},

an electrical circuit contained within said housing capable of encoding signals from said plurality of control switches for transmission through said infrared light diode {col. 3, lines 39-42}, and

a power supply mounted within said housing for supplying power for said electrical circuitry {col. 3, lines 36-40}.

8. Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,483,440 (Welch).

Claims 13 and 18 recite the limitations of claim 1, with claim 13 further controlling a VCR and claim 18 further controlling a DVD. Welch does not disclose expressly

controlling a VCR or DVD. However, these claim limitations are conventional in appliance remote controllers that are readily available in the market and would have been obvious in the system of Welch, to one of ordinary skill in the art, because Welch suggests of employing a universal controller for controlling a complete entertainment center, television or other system {paragraph bridging cols. 2 and 3}. Most entertainment centers are usually equipped with VCR's and DVD's hooked to the television set.

9. Claims 1, 2, 7, 9 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,701,123 (Samulewicz).

In claims 1, 2, 9 and 13, Samulewicz teaches of an ergonomic remote control device for the remote control of a television set and VCR, the remote control device comprising:

a housing substantially in the shape of a control stick, adapted for being held by a human hand and being manipulated by the digits of the hand, fixed to a base (11) such that the housing will stand upright as shown in figure 1 {col. 3, lines 43+},

a plurality of control switches (21, 23, 25) mounted on said control stick positioned to be manipulated by the digits of the hand,

an infrared transmitting light diode housed in said control stick for transmitting television viewing control signals to a television set and for transmitting VCR control signals to a VCR {col. 3, lines 54-57},

an electrical circuit contained within said housing capable of encoding signals from said plurality of control switches for transmission through said infrared light diode {col. 3, lines 48+}, and

a battery power supply (31) mounted within said housing for supplying power for said electrical circuitry {col. 4, lines 17-18}.

In claim 7, said plurality of switches further comprises at least one readily available finger trigger switch (15) mounted on the back upper portion of the control stick.

10. Claims 1, 2, 5, 9 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,457,448 (Totsuka et al).

In claims 1, 2, 9 and 13, Totsuka et al teach of an ergonomic remote control device (10) for the remote control of a television set and VCR, the remote control device comprising:

a housing substantially in the shape of a control stick, adapted for being held by a human hand and being manipulated by the digits of the hand, fixed to a base (50) such that the housing will stand upright as shown in figures 1, 3, 5 {col. 2, lines 53+; col. 3, lines 43-50},

a plurality of control switches (12, 14, 16, 17) mounted on said control stick positioned to be manipulated by the digits of the hand,

an infrared transmitting light diode (32) shown in figure 4, housed in said control stick for transmitting television viewing control signals to a television set and for transmitting VCR control signals to a VCR (34),

an electrical circuit shown in figure 4, contained within said housing capable of encoding signals from said plurality of control switches for transmission through said infrared light diode (32) {col. 3, lines 37-42}, and

a battery power supply (40) mounted within said housing for supplying power for said electrical circuitry.

In claim 5, the television control functions of the various said plurality of switches are user programmable {col. 3, lines 24+}.

11. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,457,448 (Totsuka et al).

In claims 3 and 4, although Totsuka et al do not disclose expressly a "thumb switch having a four position switch", the claimed switch is a combination of switches 12 and 14 of Totsuka, which are obviously manipulated by the thumb, to one of ordinary skill in the art. Alternatively, the claimed switch (usually a cross type formation) and the switches of Totsuka are interchangeable in readily available remote controllers. It would have been just a matter of obvious design choice to have a four position switch in the system of Totsuka et al based on the clarity of presenting television volume and the television channel selection, to one of ordinary skill in the art.

In claim 6, obviously, the combination of switches 12, 14 and 17, as shown on the figures, is an equivalent of a five position switch controlling the television up volume, down volume, mute, channel up, and channel down functions, to one of ordinary skill in the art.

12. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,701,123 (Samulewicz) in view of USP 5,457,448 (Totsuka et al).

In claim 18, Samulewicz or Totsuka et al do not disclose expressly controlling a DVD. However, the systems of Samulewicz or Totsuka et al are capable of interchangeably controlling either a television or a VCR by flipping a switch. The only difference between a VCR and a DVD is the portable memory used for storage (i.e. tape vs. CD). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use a DVD in the system of either Samulewicz or Totsuka et al, because the manner of controlling a VCR is the same as controlling a DVD, to one of ordinary skill in the art.

In claim 8, Samulewicz do not disclose "said electrical circuit is further adapted with a memory for retaining a plurality user programmable television channels {Totsuka et al, col. 3, lines 24-42}". In this case, Totsuka et al in the same field of endeavor, teach of a programmable remote control unit for controlling various other kinds of

electronic equipment {Totsuka, col. 3, lines 24+}. Clearly, this feature is desirable in the system of Samulewicz. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a programmable remote controller in the system of Samulewicz, because a programmable remote control unit can be made to control various other kinds of electronic equipment, as taught by Totsuka.

    said memory being successively accessed by activation of said trigger switch to signal a change in channel {Samulewicz, col. 4, lines 30-35}.

    In claims 10 and 14, Samulewicz do not disclose expressly a "first keypad mounted in a recess on a first lateral side of said base". However, these claim limitations are an obvious design choice and would have been obvious in the system of Samulewicz, because moving the keypad to the lateral side of the base do not change the functionality of the remote control.

    Claims 11, 16 and 20, recite the combination of claims 7 and 8, and therefore rejected for the same reasons.

    Claim 12 recites the combination of claims 3 and 11, and therefore rejected for the same reasons.

    In claims 15 and 19, Samulewicz do not disclose expressly a second keypad. However, flipping the switch 21 between VCR and TV is obviously the equivalent of having a first and second keypad, to one of ordinary skill in the art.

    Claim 17 recites the combination of claims 4, 11 and 16, and therefore rejected for the same reasons.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 6,144,367 (Berstis) is cited in that it teaches of joystick type remote controllers (101, 103) and four and five position switch on a remote control as shown in figures 1A and 1D.

USP 4,052,582 (Mullen et al) is cited in that it teaches of a rotary switch having four and five position switch {see whole document}.

### ***Office Contact Information***

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is **(571)-272-3065**. The Examiner can normally be reached on 4/4/10.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Horabik can be reached on **(571)-272-3068**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William L. Bangachon  
Examiner  
Art Unit 2635

October 21, 2005

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